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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,254	10/25/2001	Kelly H. McClure	A01P1012US01	8110

36802 7590 10/05/2004

PACESETTER, INC.
15900 VALLEY VIEW COURT
SYLMAR, CA 91392-9221

EXAMINER	
SCHAETZLE, KENNEDY	

ART UNIT	PAPER NUMBER
3762	

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/033,254	MCCLURE ET AL.	
	Examiner	Art Unit	
	Kennedy Schaetzle	3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 June 2004 and 01 July 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7* is/are pending in the application.

4a) Of the above claim(s) *5-7* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 2* is/are rejected.

7)☒ Claim(s) *3 and 4* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *25 October 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on June 24, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of the full statutory period of U.S. Patent 6,539,259 B1 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent; except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Weinberg et al. (Pat. No. 6,539,259)

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Weinberg et al. teach a method wherein cardiac signals are sensed, pairs of consecutive R-waves and T-waves are identified (see Fig. 2), values representative of characteristics of pairs of R-waves and T-waves are measured (coupling interval T2), statistical information representative of the measured values are generated and stored (note col. 4, lines 1-5).

Regarding the generation of an average, Weinberg et al. disclose that a mean may be determined (col. 13, line 10). Webster's New World Dictionary (3rd college edition, 1988) defines the word *mean* as "...unless other qualified, the arithmetic mean...." The arithmetic mean is defined as "...the average obtained by dividing a sum by the number of its addends." Since the applicants have not clearly set forth the definition of "mean" explicitly and with reasonable clarity, deliberateness and precision, this term will be interpreted as broadly as the definitions allow. An average is thus considered to be equivalent to a mean in this context.

Response to Arguments

4. Applicant's arguments filed June 24, 2004 and July 1, 2004 have been fully considered but they are not persuasive.

In regards to the rejection of claims 1 and 2 under 35 U.S.C. §102(e), the applicants argue that the Weinberg et al. reference does not teach every element of claim 1. The applicants refer to comments in the previous Office Action wherein the examiner stated that the step of storing statistical information generated for the measured values was considered obvious because if one is attempting to use the statistical information to predict an expected location of a T-wave, one must have this information stored in memory beforehand. It is argued that because the examiner used the word "obvious" to describe this limitation, the rejection under §102(e) cannot stand since the reference does not anticipate the claims.

The examiner argues that the section of the previous Office Action that the applicants are referring to (see pars. 3 and 4 of the previous Office Action) does not apply to the rejection of claims 1 and 2 under 35 U.S.C. §102(e). The examiner intended this comment to apply only to the obviousness-type double patenting rejection –not the §102(e) rejection. In a double patenting rejection, the examiner cannot rely upon the reference's specification to support the rejection –only the claims and secondary references may be considered. In a rejection under §102(e), however, the examiner may rely upon the entire disclosure of the reference to supply support for limitations that may not be present in the patented claims. If, for example, the

applicants' claim 1 recited steps A, B and C, and the examiner found a reference that claimed steps A and B but only discussed step C in the specification, then it is entirely appropriate and congruous for the examiner to consider the claimed invention obvious in view of the patented claims for the purposes of double patenting, and anticipatory in view of the entire prior art document for the purposes of the art rejection. The applicants have failed argued the examiner's position on the 102(e) rejection as set forth under section 7 of the previous Office Action which explicitly directed the applicants' attention to the section of the Weinberg et al. patent that refers to the storing of statistical information. Because of the applicants' failure to effectively argue the examiner's position, the §102(e) rejection must stand.

The applicants' response to overcome the rejection under §103 was considered effective.

Allowable Subject Matter

5. Claims 3 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The recited determining steps have not been disclosed by prior artisans in a method of the type set forth in claim 2.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kennedy Schaetzle whose telephone number is 703 308-2211. The examiner can normally be reached on M-W and F from 9:30 -6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 703 308-0851. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KJS
October 1, 2004

KENNEDY SCHAETZLE
PRIMARY EXAMINER